

Rebuttal to Petition for Cancellation in the United States Patent and Trademark Office**THE UNITED STATES PATENT AND TRADEMARK OFFICE****BEFORE THE TRADEMARK AND APPEAL BOARD****In the Matter of Registration No. 3418196****Issued on April 28, 2008****Shirley's World, L.P.****Cancellation No. 92057484**

Petitioner

v.

Earl C.J. Prater**Registrant****Rebuttal To Petition For Cancellation****Registration No. 3418196 The Original Shirley Temple Diet Soda Pop**

Registrant, Earl C.J. Prater, an individual, residing in Reno-Sparks, Nevada, believes that he is being damaged by the Petitioner, Shirley's World L.P., a California Limited Partnership, located at 101 Lakeview Drive, Woodside, CA 94062, regarding the Petition for Cancellation, Number 92057506.

1. The Registrant, Earl C.J. Prater, an individual and a resident of Reno-Sparks, Nevada, has a mailing address of P.O. Box 51542 Sparks, Nevada 89435-1542 to which all postal mail is delivered and an electronic mailing address of shirleytemplesodapop@gmail.com filed with the USPTO and first filed under trademark application number 78345712 December 26, 2003. The



11-26-2013

U.S. Patent & TMO Form Mail Prot Dt. #22

Registrant is the owner of United States Trademark Registration No. 3418196 for THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP comprising "Non-alcoholic beverages, namely, carbonated beverages; pop; soda pops; soft drinks; and soft drinks, namely, soda pop flavored like a Shirley Temple under Class 32.

2. The Registrant does claim a date of first use of the brand and mark, THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP design character mark as early as May 2, 2003 for the trademark application serial number 78345712 submitted December 26, 2003, published for opposition in the Trademark Official Gazette February 12, 2008 and Trademark Registration Certificate No. 3418196 granted April 29, 2008. The Registrant did not learn of any cancellation action being taken against his use of the mark until notification by email from the USPTO on July 15, 2013, ESTTA number 9205706, first read by Registrant August 5, 2013 originating from Shirley's World LP, the Petitioner, filed July 9, 2013.

3. The Registrant has not abandoned Registration No. 3418196 or use of the mark for The Original Shirley Temple Diet Soda Pop. The canned and bottled beverage products and premix and post mix syrups are produced, marketed, distributed and sold throughout the United States and Canada.

4. The Registrant owns the trademark rights, trademark name and design of The Original Shirley Temple Diet Soda Pop products and has the legal authority to produce, market, distribute, advertise, promote and sell his carbonated soft drink products nationally and internationally.

5. The Registrant does not produce DVD sets, collectible dolls, collectible plates, collectible mugs, or collectible trinket items. The Registrant has produced Shirley Temple Soda Pop

carbonated soft drink products since April 15, 1987 well before the Petitioner has claimed first production of their DVD sets, collectible dolls, collectible plates, collectable mugs and collectible trinket items non beverage products since 1999. The Registrant has received trademarked registrations for his Shirley Temple Soda Pop products April 23, 1991, February 19, 2002, April 28, 2008 and August 14, 2012.

6. Registrant's use of the registered trademark 3418196, The Original Shirley Temple Diet Soda Pop, and all previously trademarked Shirley Temple Soda Pop products manufactured since 1987, has not caused any confusion, mistake or deception in the public or trade as to the source of origin of the Registrant's goods. It is always disclosed, if asked, that the products have been created by the Registrant, is legally trademarked and the Registrant has the legal right to produce, license, market, promote, advertise, distribute and sell his trademarked beverage products throughout the United States and Canada. It has been vital to our business success to have obtained and maintained our trademarks. Without trademark protection all created designs, logos, and colors of our products could be copied and it would have a disastrous affect upon successfully building our business and manufacturing and marketing our products. Because of trademark protection, we have been able to legally produce, license, distribute, market, promote and sell our Shirley Temple Soda Pop products.

7. The continued use and existence of the Registrant's trademarked Shirley Temple Soda Pop products since 1987 have not and will not "cast a cloud" upon the Petitioner's right to produce it's DVD sets, movies, dolls, apparel, collectible dolls, collectible plates, collective mugs or collectible trinket items as claimed since first introduced in 1999 long after the first production of trademarked Shirley Temple Soda Pop products in 1987. The Petitioner, to our knowledge, does not produce Shirley Temple beverage products, has never produced Shirley Temple

beverage products nor has ever trademarked Shirley Temple beverage products. There has not been nor should be any confusion in the public or trade regarding the products our businesses produce because they are not the same or similar. If the Petitioner decides to produce or trademark a Shirley Temple beverage product it may "cast a cloud" over the Registrant's established trademarked products. We would have no objection, however, to the Petitioner manufacturing or obtaining trademarks for Shirley Temple beverage products as long as it does not infringe upon our trademark designs, colors, logo, brand names and the like to cause any confusion in the market. There are approximately five different companies producing Shirley Temple named carbonated beverage products in the U.S. at this time. They can be found on the Internet as well as our company and products.

On April 15, 1987 I released my first production of The Original Shirley Temple Soda Pop carbonated soft drink beverage. The Original Shirley Temple Diet Soda Pop was also produced and released on that date. I also applied for my first trademark that year for The Original Shirley Temple Soda Pop but not for The Original Shirley Temple Diet Soda Pop. In 1988 another company by the name of Soda Pop Kids released their first production of "Shirley T Shirley Temple" carbonated soft drink beverage. Mrs. Shirley Temple Black objected to this company using the name Shirley Temple and had won an injunction against it to stop production of their product. There was considerable press coverage about this company. An article in the newspapers was also written about my company producing a Shirley Temple beverage. I had decided to write a personal letter to Mrs. Black explaining who I was and how I had met her by introduction from a member of her staff in Washington D.C. when she was Chief of Protocol for the U.S. Department of State and former Ambassador. I was a U.S Foreign Service Officer and I had volunteered to help out periodically with various State Department Office of Protocol

functions. I had asked Mrs. Black if she remembered me and if she had any objection to my continuing to produce my products. She never responded. I continued producing my products. My first trademark application submitted in 1987, published for opposition July 26, 1988, was approved and registered April 23, 1991. I have been producing and applying for trademarks since then. It wasn't until July 8, 2013 that there was a Petition for Cancellation submitted to the USPTO against my trademark by Shirley's World L.P. Over the past twenty six years I have never been requested by Mrs. Black to cease production of my products nor has there been any legal action taken against me by her to have my trademarks cancelled.

9. The Registrant denies obtaining Registration No. 3418196 fraudulently or making a false material representation of fact in response November 16, 2004 to the USPTO Examining Attorney's inquiry. As I had stated, "The name of my soft drink , The Original Shirley Temple Soda Pop, first U.S. trademarked April 23, 1991 and subsequently trademarked February 19, 2002 , does not identify a living individual but the name of the carbonated soft drink only." My first two trademarks were approved and registered for a product not a person. As restated and clarified with the examining attorney, "The name Shirley Temple in the submitted mark and drawing of The Original Shirley Temple Diet Soda Pop carbonated soft drink beverage is a product not a person." This third trademark was also approved by the USPTO on this fact. The product does not identify nor implies any relationship to any living individual." It identifies a product only, not a person. It is produced, marketed and sold as a product. It has been a product consumed by the name Shirley Temple for over seventy five years by the public. What I have produced and trademarked for the past twenty five years is a canned or packaged beverage product named after a generic beverage product known and sold for over seventy five years as a

Shirley Temple beverage not a person. I was the first person to can it, brand it and get it trademarked.

WHEREFORE, the Registrant believes that he has been and is being damaged by the Petitioner in the attempted cancellation filed July 8, 2013 against Registration No. 341896 granted April 28, 2008, far beyond the statute of limitations period after his trademark registration was granted and that this action is currently and negatively affecting his business since the attempted cancellation notices have been made public through the USPTO process. The Registrant prays that this Petition for Cancellation be denied in favor of the Registrant and that judgment not be entered against the Registrant in order to maintain trademark protection for the continued production of goods and success of the business.

Dated: November 22, 2013

Earl C.J. Prater

A handwritten signature in black ink, appearing to read 'Earl C.J. Prater', written over a horizontal line.

Registrant

CERTIFICATE OF SERVICE

November 22, 2013

Reference Cancellation No. 92057484

United States Patent and Trademark Office

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313

The undersigned hereby certifies that a true and correct copy of the foregoing Cancellation No. 92057484 was served upon Petitioner by forwarding said copy, via first class mail, postage prepaid to:

Jackie M. Joseph

Eisner Kahan Gorry Chapman Rosse & Jaffe

9601 Wilshire Blvd, Suite 700

Beverly Hills, CA 90210

United States

Respectfully yours,

A handwritten signature in black ink, appearing to be 'E. Prater', written over a horizontal line.

Earl C. J. Prater

P.O. Box 51542

Sparks, NV 89435-1542